

REMARKS

Claims 1, 2, 4-14, and 16-24 are pending in the Application.

Claims 1, 2, 4-14, and 16-24 have been rejected.

Claims 1, 7, 13, and 19 have been amended. No new matter has been added. Support for the amendments to Claims 1 and 13 can be found throughout the originally-filed Application and, at least, within paragraph [0042]. Support for the amendments to Claims 7 and 19 can be found throughout the originally-filed Application and, at least, within paragraphs [0006] and [0029] – [0031].

Examiner Interview

Appreciation is expressed for the telephonic interview conducted on May 28, 2009 between the Examiner and counsel for Applicants. During the interview, the cited references were discussed with regard to the independent claims. The Examiner agreed that the present amendments would overcome the current rejections but that a new search might be necessary. Given this agreement that the amendments advance prosecution, Applicants are filing the present RCE.

Rejection of Claims under 35 U.S.C. § 103

Claims 1-2, 4-14, and 16-24 stand rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over U.S. Patent No. 6,405,284 issued to Bridge (“Bridge”), U.S. Patent No. 5,819,310 issued to Vishlitzky et al. (“Vishlitzky”), and U.S. Patent Application No. 2003/0074528 issued to Soejima et al. (“Soejima”). Applicants respectfully traverse these rejections.

In order for a claim to be rendered invalid under 35 U.S.C. §103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. §103(a). This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3)

there must be a reasonable expectation of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Applicants submit that neither Bridge, nor Vishlitzky, nor Soejima, alone or in combination, teach or contemplate the “allocating” limitation occurring only if the “determining” limitation determines that each of the remaining operations can be performed, as claimed. During the interview, the Examiner agreed that none of the cited references disclose any such conditional performance of an “allocating” limitation depending on a “determining” limitation. For at least these reasons, Applicants respectfully submit that independent Claims 1 and 13, as amended, and all claims depending therefrom, are in condition for allowance.

Dependent Claims 7 and 19 have been amended to recite:

successful performance of at least one operation of the set of operations is
dependent on the effect of performing another operation of the set of
operations.

See, e.g., Claim 7 (as amended). Applicants respectfully submit that neither Bridge, nor Vishlitzky, nor Soejima, alone or in combination, teach or contemplate the limitations of Claims 7 and 19.

Bridge’s method makes a determination based on one criterion: whether enough full mirror partners are available to perform the remaining allocations. *See* Bridge 19:23-61. This type of determination in Bridge is a simple binary determination. Bridge’s determination is not based on the effect of the successful performance of at least one operation on another operation. In Bridge, the only consideration given with respect to the operations is their quantity. There is no indication in Bridge that the performance of any single operation depends on the successful performance of any other operation. Bridge’s method does not contemplate any scenario where the sequence of operations makes a difference because Bridge does not contemplate any dependencies between operations. Thus, Bridge cannot be said to teach or contemplate that “successful performance of at least one operation of the set of operations [being] dependent on the effect of performing another operation of the set of operations.”

Vishlitzky is cited only for the proposition of considering multiple volumes. Applicants respectfully submit that the cited sections of Vishlitzky fail to provide support for anything pertaining to the “successful performance of at least one operation of the set of operations

[being] dependent on the effect of performing another operation of the set of operations.” The disclosure of multiple volumes does not teach or contemplate anything related to how the successful performance of at least one operation of a set of operations is dependent on the effect of performing another operation. Thus, Vishlitzky does not cure the defect that Bridge suffers in teaching or contemplating this limitation.

Soejima pertains to ensuring that the performance of other, pre-existing data volumes is not adversely affected by the creation of a single additional volume. *See, e.g.*, Soejima ¶¶ [0015] and [0016]. Because Soejima is only directed to the allocation of a single volume at a time, Soejima cannot be said to teach or contemplate anything regarding performing a set of operations. Because the cited sections of Soejima do not disclose the performance sets of operations, Soejima cannot be said to teach or contemplate “successful performance of at least one operation of the set of operations is dependent on the effect of performing another operation.” Thus, Soejima does not cure the defect that Bridge and Vishlitzky suffer in teaching or contemplating this limitation of Claims 7 and 19.

For at least these reasons, Applicants submit that neither Bridge, nor Vishlitzky, nor Soejima, alone or in combination, provide disclosure of all the limitations of Claims 7 and 19, as amended, and all claims depending therefrom, and that these claims are in condition for allowance. Applicants therefore respectfully request the Examiner’s reconsideration and withdrawal of the rejections to independent Claims 1 and 13 and dependent Claims 7 and 19, as amended, and all claims depending therefrom and an indication of the allowability of same.

CONCLUSION

Applicants submit that all claims are now in condition for allowance, and an early notice to that effect is earnestly solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to telephone the undersigned.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicants hereby petition for such extensions. Applicants also hereby authorize that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to Deposit Account 502306.

Respectfully submitted,

/Jonathan N. Geld/

Jonathan N. Geld
Attorney for Applicants
Reg. No. 44,702
Telephone: (512) 439-5090
Facsimile: (512) 439-5099